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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,235	04/29/2005	Masaya Nishio	271564US0PCT	5068
22850	7590	10/19/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER WINTERBERG, NISSA M	
			ART UNIT 1618	PAPER NUMBER
			NOTIFICATION DATE 10/19/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/533,235

**Applicant(s)**

NISHIO, MASAYA

**Examiner**

Nissa M. Westerberg

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/1/09, 7/31/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 20 - 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 20 - 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 1, 2009 has been entered.
2. Applicants' arguments, filed July 1, 2009, have been fully considered but they are not deemed to be fully persuasive. The following rejections and/or objections constitute the complete set presently being applied to the instant application.

***Claim Rejections - 35 USC § 112—2<sup>nd</sup> Paragraph***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 12 and 20 – 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if the weight percentages for

components (B-1) and (B-2) refer only to the total weight of component (B) or are calculated based on the total weight of the composition, including component (A).

Please clarify.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 12, 20, and 23 – 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07-277923) in view of Ziemelis et al (US 4,474,923). This rejection is MAINTAINED for the reasons of record set forth in the Office Action mailed April 1, 2009 and those set forth below.

Applicant traverses this rejection on the grounds that a sprayable composition is not disclosed or suggested by the cited prior art. The viscosities of various materials in their pure state were provided. The cited prior art does not suggest how to interblend the ingredients (A) and (B) to make a sprayable skin care compositions, and the instant specification discloses that sprayable compositions have a low viscosity. Careful selection of the ingredients must be provided in order to provide a skin care composition that is easy to spray. The prior art does not provide a reasonable expectation of success for providing a sprayable compositions, and the superior sprayability and skin protective properties. In regards to Ziemelis et al., Applicant argues that Ziemelis does not disclose the compositions used by the claimed method, or suggest how to interblend ingredients (A), (B-1) and (B-2).

These arguments are unpersuasive. The Examiner has previously discussed that this art teaches that liquid isoparaffin (B-1), liquid paraffin or squalene (B-2) can be present in the compositions that also include element (A) of the instant claims and the aforementioned essential components (¶ [0013]). The lipstick and foundations do contain any water and therefore have a have a water content of not more than 1 wt%. Ziemelis discloses that a variety of mean such as wiping, rubbing or spraying can be used to apply such cosmetic compositions (col 6, ln 62 - col 7, ln 2). It would be within the skill and obvious to one of ordinary skill to vary the amounts of the different components to prepare a composition with a final viscosity appropriate to the type of product being prepared. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely

optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ and reasonably would expect success. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results. For example, a lipstick product is not applied by spraying and is rubbed on, requiring a higher viscosity composition, which would alter the ingredients and relative amounts of those ingredients over a composition that would be sprayed onto the skin, such as a sunscreen, to allow for easy, rapid application to a large area of skin.

Note, in order to overcome a *prima facie* case of obviousness, it is incumbent upon the Applicant to provide comparative test evidence that demonstrates unexpected superiority of the claimed compositions versus the closest prior art compositions, and not simply an advantage predictable from the prior art. See *In re Chapman*, 148 USPQ 711, 715 (CCPA, 1966). Moreover, such proffered comparisons must be commensurate in scope with the breadth of the claims. See *In re Clemens*, 206 USPQ 289, 296 (CCPA, 1980) and *In re Coleman*, 205 USPQ 1172, 1175 (CCPA 1980). Evidence for such comparisons has not been submitted.

8. Claims 12 and 20 -25 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 07-277923 in view Nakanishi (US 2002/0131947) and the International Cosmetic Ingredient Dictionary and Handbook (7<sup>th</sup> edition, 1997; p 1656 – 1657; 1657 – 1669; "ICIDH").

JP'923 discloses oil-based cosmetics whose inherent adhesiveness is improved, stickiness is reduced and having favorable stability (§ [0001]). These effects are caused by the used of side-chain-block copolymer polyether modified silicon with the formula of general formula 2, which reads on the formula of claim 24, and one or more polar oils having a liquid like external appearance (§ [0005]). The optimum quantity in the final products of the block copolymer is 1.0 – 50 wt percent (§ [0008]) with 3.0 – 50% wt percent of liquid polar oil (§ [0009]). Among the liquid polar oils disclosed by JP'923 are the fatty acid tryglyceride glyceride tri(caprylate/caprates) (p 8, last line – first line, p 9). In addition to these essential components, other ingredient such as liquid paraffin and squalene can be included (§ [0013]). The oil-based cosmetic can be used in conventional forms such as lipsticks, foundation, rouge, lip balms and the like (§ [0014]). As shown in the examples, none of these cosmetics contain water and therefore meet the limitation of having at most 1% water.

JP'923 does not disclose the application by spraying of these compositions on the skin.

Nakanishi discloses oil based cosmetic contain modified silicones (abstract). It is preferred that part or all of the oil base be liquid at ordinary temperatures and such bases can be used for solid, semi-solid or liquid when used for cosmetic materials (§§ [0067] – [0068]). Various compounds that can be used in the oil base are given (§§ [0069] - [0074]), such as liquid paraffin, squalene (§ [0070]), isopropyl myristate (§ [0072]) or the cyclomethicone decamethycyclopentasiloxane (§ [0073]). Those cosmetic materials may be skin care products such as lotions or creams, makeup products such

as foundation or lipsticks and may be a liquid, emulsion, solid, paste or spray products (¶ [0110]).

The ICIDH states that cyclomethicones are emollient skin conditioning agents that help to maintain the soft, smooth and pliable appearance of the skin (p 1656 – 1657). Squalene and paraffin are examples of occlusive skin conditioning agents that retard evaporation of water from the skin surface (p 1667 – 1669).

It would have been obvious to the person of ordinary skill in the art at the time the invention was made to prepare the stable, adhesive while not be sticky oil-based cosmetic formulation as a composition that can be sprayed and applied to the skin of a user . The person of ordinary skill in the art would have been motivated to make those modifications and reasonably would have expected success as Nakinishi discloses that silicone polymer containing oil-based cosmetics can take a variety of forms, not only the solid foundation and lipstick of JP'723, but also forms such as lotions or creams that can be sprayed. For example, a lotion is applied to a much larger area than a lipstick and can be more easily applied to that larger surface area by spraying rather than by rubbing on a solid form like that of a lipstick. Therefore, one of ordinary skill in the art would select ingredients from those disclosed in JP'723, Nakinishi and the ICIDH to produce an oil based cosmetic with emollient properties from the decamethylcycllopentasiloxane and occlusive properties from the squalene and/or paraffin. The selection of those ingredients and the amounts of those ingredients are part of routine experimentation and optimization by one of ordinary skill in the art. The amount of a specific ingredient in a composition is clearly a result effective parameter



that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ and reasonably would expect success. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient to add in order to best achieve the desired results, such as a cosmetic product with a consistency of a lotion, for example, that could be applied to large areas of skin by spraying. Because of the various properties of the ingredients in the cosmetic (e.g., emollient and occlusive properties), the skin of the subject would be protected.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nissa M. Westerberg whose telephone number is (571)270-3532. The examiner can normally be reached on M - F, 8:00 a.m. - 4 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jake M. Vu/  
Primary Examiner, Art Unit 1618

NMW